REMARKS

The Office Action mailed May 28, 2008 set an initial one month or thirty (30) day period for response, whichever is longer. Accordingly, this Response is timely filed without extension of time up to November 28, 2008.

The Office Action mailed November 28, 2008 required restriction between Groups I to III:

> Group I, claims 31-46, drawn to an isolated adipocyspin polypeptide;
>
> Group II, claims 47-67, drawn to a method of use for the adipocyspin polypeptide; and
>
> Group III, claims 68-71, drawn to a method of use for the adipocyspin polypeptide.

In response to the Examiner's restriction requirement, Applicants provisionally elect the invention of Group II, Claims 47 to 67, with traverse.

Applicants submit that the provisionally elected polypeptides, and the polynucleotides they encode, as well as the methods of using the polypeptides from a coherent invention and are properly examinable together without undue burden.

In the May 28, 2008 Office Action, the Examiner required further election of a single disclosed species, also with traverse. In response, Applicants provisionally elect the polypeptide of SEQ I.D. No. 2 (a human adipocyspin). Claims 47 to 56, 61 to 67 are readable on the provisionally elected species. Applicants note that the present application describes a limited number of species of adipocyspin proteins including those of SEQ ID Nos. 1, 2, 9, and 10. Applicants submit that these species are sufficiently related so as to be examinable together without undue burden.

Applicants request that the Examiner expand the scope of the search upon finding of allowable species, as noted by the Examiner on page 3.

Applicants request that the invention of Group III, directed to methods of using the polypeptides of Group II be rejoined with provisionally elected Group II.

With regard to the Examiner's discussion of PCT Rule 13.2 in the present Office Action. Applicants note that although PCT Rule 13.2 may be applicable to examination of a PCT application during the International Phase, the present application has now entered the U.S. National Phase under 35 U.S.C. § 371 and United States patent practice is applicable. Applicants question the pertinence of the Examiner's discussion of PCT Rules 13.1 and 13.2 in support of the present restriction requirement.

Applicants submit that claims 31 to 71 are sufficiently related to be properly examined together and without undue burden on the Examiner.

In general, in addition to the element of burden, restriction requirements are proper where (1) the application recites two or more independent inventions, (2) the application recites two or more patentably distinct inventions, or (3) the application recites two or more patentably distinct species without an allowable generic claim encompassing the species. Applicants respectfully submit that the Examiner has not provided a *prima facie* case in support of restriction.

The Patent Office can make a *prima facie* showing of serious burden by demonstrating that the related inventions: (1) are separately classified; (2) where they are classified together, have a separate status in the art; or (3) require a different field of search. M.P.E.P. §808.02. This has not been done. Additionally, there is no indication from the May 28, 2008 Restriction Requirement that the grouped inventions have acquired a separate status in the art – whether by their classifications or otherwise. In fact, the Examiner has not indicated classification for the claims. Nor is there any indication that a different field of search be required for the claims of Groups I to III in light of the related nature of the inventions.

In sum, Applicants respectfully submit that there is no serious burden on the Patent Office to search the art for with regard to the inventions of claims 31 through 71, and request that the restriction requirement be reconsidered and withdrawn.

Applicants note that Group I is directed to an isolated polynucleotide which encodes an adipocyspin polypeptide. Group II is directed isolated adipocyspin polypeptides. Group III is directed to methods of using the adipocyspin polypeptides. .

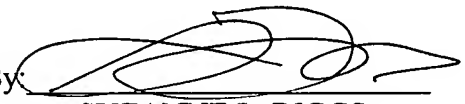
CONCLUSION

For the reasons set forth above, Applicants request that the Examiner reconsider the restriction requirement and that pending claims 31 through 71 be examined as a whole. Applicants note that, as required, they have provisionally elected the invention of Group I with traverse as well as provisionally elected the species using the sequence of SEQ ID No.: 2, also with traverse. The Examiner is encouraged to contact the undersigned if it is believed that a telephonic interview would expedite prosecution.

Commissioner is hereby authorized to charge any requisite fees for this submission, or any fees in connection with this application during its entire pendency, or to credit any overpayment, to Deposit Account No. 04-1679.

Dated: November 26, 2008

Respectfully submitted,

By: 

SUZANNE L. BIGGS
Reg. No. 30,158

DUANE MORRIS LLP
101 West Broadway, Suite 900
San Diego, CA 92101-8285
(O) 619.578.2200
(F) 619.744.2201